

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PARK HONG

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Appeal No. 96-3999  
Application No. 08/395,719<sup>1</sup>

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ON BRIEF

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Before CALVERT, NASE, and CRAWFORD, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 and 6. Claim 4 has been objected to as depending from a non allowed claim. Claims 2 and 5 have been canceled.

We AFFIRM-IN-PART and enter new rejections pursuant to

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<sup>1</sup> Application for patent filed February 28, 1995.

Appeal No. 96-3999  
Application No. 08/395,719

37 CFR § 1.196(b)<sup>2</sup>.

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<sup>2</sup> Amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997).

BACKGROUND

The appellant's invention relates to a stackable container. An understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the appendix to this decision.

The prior art references of record relied upon by the examiner as evidence of anticipation under 35 U.S.C. § 102(b) and obviousness under 35 U.S.C. § 103 are:

Bourcart	2,663,450	Dec. 22, 1953
Westgate	3,018,931	Jan. 30, 1962
Pepicelli (Pepicelli)	4,294,924	Oct. 13, 1981

Reference made of record by this panel of the Board is:

Torras	2,077,027	Apr. 13, 1937
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Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Bourcart.

Claims 1, 3 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pepicelli in view of Westgate.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 102(b) and § 103

rejections, we make reference to the examiner's answer (Paper No. 9, mailed April 1, 1996) and the supplemental examiner's answer (Paper No. 11, mailed May 20, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 8, filed March 8, 1996) and reply brief (Paper No. 10, filed April 29, 1996) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### **35 U.S.C. § 102(b) Rejection**

We sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b)<sup>3</sup> as being anticipated by Bourcart.

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<sup>3</sup> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

The examiner determined (answer, p. 6) that

Bourcart discloses a stackable container as shown in Fig. 3 comprising a hollow cylinder 41, integral top wall 42, integral bottom wall with a circular well 51 and tubular threaded mouth member 43 which receives threaded cap 44. The well has a diameter which would receive the mouth of a second like container and allow stacking of the containers with a close fitting sliding interlocking relationship.

The appellant argues (reply brief, p. 2) that the following limitations of claim 1 are not met by Bourcart. First, that the well at the bottom of the container has "a selected diameter to receive the tubular mouth member of a second like container to enable the first container to be stacked on top of the second container" is not met by Bourcart since the shallow recess at the bottom of his vial of Figure 3 is configured to receive the cap of an entirely different container. Second, that "the outer diameter of the annular skirt portion of said cover and the inner diameter of the well are selected to enable the first container to be stacked over the second container in a close fitting sliding interlocking relationship" is not met by Bourcart since any attempt to place the vial of Figure 3 on top of a similar vial would cause the upper vial to tip over as the diameter of the cover in Bourcart is not selected to enable the first container to be fitted over a second like container in a close fitting sliding interlocking relationship.

Thus, before deciding this rejection, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline  
Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will now direct our attention to appellant's claim 1 to derive an understanding of the scope and content thereof.

Claim 1 recites "[a] first stackable container . . . comprising: a hollow cylinder having an integral top wall and an integral bottom wall, a tubular mouth member formed integral with the top wall and centrally located on the top wall coaxial with the hollow cylinder, . . . ; said bottom wall having a circular well centrally formed therein coaxial with said cylinder and extending upwardly into the interior of said cylinder, and said well having a selected diameter to receive the tubular mouth member of a second like container to enable the first container to be stacked on top of the second container; a cover having an internally threaded annular skirt portion removably mounted on

said tubular mouth member in threaded engagement therewith and with said skirt portion extending down over said tubular mouth member, and in which the outer diameter of the annular skirt portion of said cover and the inner diameter of the well are selected to enable the first container to be stacked over the second container in a close fitting sliding interlocking relationship."

Our review of independent claim 1 reveals that we are unable to derive a proper understanding of the scope and content thereof. Specifically, it is our determination that claim 1 is subject to two interpretations: one interpretation would support the examiner's rejection of claim 1 as being anticipated by Bourcart and the other interpretation would not support the examiner's rejection of claim 1 as being anticipated by Bourcart. The first interpretation is that the claim is directed to a first container adapted to stack with another container wherein the covers of the two containers may have different diameters. The second interpretation is that the claim is directed to a first container adapted to stack with another container wherein both containers must have covers with the same diameter. Since we are unable to derive a proper understanding of the scope and content of claim 1, we believe that the proper course of action is to

enter a rejection based on indefiniteness under 35 U.S.C. § 112, second paragraph.

We recognize the inconsistency implicit in our holding that claim 1 is rejectable under 35 U.S.C. § 112, second paragraph, with a holding that claim 1 is anticipated under 35 U.S.C. § 102. Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, a determination as to patentability over the prior art is not made. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). However, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. See Ex parte Ionescu, 222 USPQ 537 (Bd. App. 1984). Accordingly, we interpret appellant's claim 1 according to the above-noted first interpretation.

The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on'



something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

When applying this first interpretation, we read claim 1 on Bourcart as follows: A first stackable container (Bourcart's vial or bottle 40) for seasonings, such as salt, pepper and spices, comprising: a hollow cylinder (Bourcart's base portion 41) having an integral top wall (Bourcart's disc 42) and an integral bottom wall (see Bourcart's Figure 3), a tubular mouth member (Bourcart's neck 43) formed integral with the top wall and centrally located on the top wall coaxial with the hollow cylinder, said tubular mouth member having external threads thereon and having a reduced diameter with respect to the diameter of said top wall and extending upwardly from the plane of said top wall (see Bourcart's Figure 3); said bottom wall having a circular well (Bourcart's recess 51) centrally formed therein coaxial with said cylinder and extending upwardly into the interior of said cylinder (see Bourcart's Figure 3), and said well having a selected diameter to receive the tubular mouth member of a second like container to enable the first container to be stacked on top of the second container (Bourcart's recess 51 has a diameter designed to receive the tubular mouth member (i.e., projecting portion 49) of a second like container (e.g.,

cylindrical box 31) to enable the first container to be stacked on top of the second container as shown in Figure 1); a cover (Bourcart's lid 44) having an internally threaded annular skirt portion removably mounted on said tubular mouth member in threaded engagement therewith and with said skirt portion extending down over said tubular mouth member (see Bourcart's Figure 3), and in which the outer diameter of the annular skirt portion of said cover and the inner diameter of the well are selected to enable the first container to be stacked over the second container in a close fitting sliding interlocking relationship (since Bourcart's first container (i.e., vial 40) is stacked over the second container (e.g., cylindrical box 31) in a close fitting sliding interlocking relationship as shown in Figure 1, it is inherent that Bourcart has selected an appropriate outer diameter for the annular skirt portion of the cover (i.e., lid 44) and the inner diameter of the well (i.e., recess 51).

Since all the limitations of claim 1 are found in Bourcart, the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) is affirmed.

**35 U.S.C. § 103 Rejection**

We do not sustain the examiner's rejection of claims 1, 3 and 6 under 35 U.S.C. § 103<sup>4</sup> as being unpatentable over Pepicelli in view of Westgate.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed.

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<sup>4</sup> The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Cir. 1988). The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Pepicelli discloses a container for growing anaerobic microorganisms having a cone-shaped dish 10 and a matching cone-shaped cover 12 that define between them a prescribed volume. An overflow trough 20 surrounds the dish, and the peripheries of the dish and cover seal together by excess agar medium carrying the organisms squeezed from the volume as the cover is applied to the dish. The colonies of organisms can be viewed either through the dish or cover because each is transparent. As shown in figure 4a, the cover 12 has an outer wall or skirt 62 has an inner diameter which is slightly larger than the outer diameter of the wall 32 of the base 10 so that the cover may easily be placed in position on the base. Pepicelli teaches (column 4, lines 8--12) that the

skirt 62 fits loosely over wall 32 of the spill chamber [so that] the gas may flow out of the container and no pressure build up is created. In this fashion the container may be incubated so as to stimulate the growth of the microorganisms.

Westgate discloses a condiment container which is shaped so as to permit easy stacking of condiment containers on one another. The condiment container includes, inter alia, a glass or clear plastic jar 10, a fitment 15 and a cap 45. The cap 45 may be threaded and is provided with an annular ridge 46. The fitment 15 is provided with sifting holes 20. The jar 10 has a neck 11 provided with an external thread 13 and a recess 47 provided in the bottom of the jar. The recess 47 and ridge 46 aid in the stacking of the jars so that one jar can be mounted on top of another.

The examiner determined (answer, p. 5) that

[i]t would have been obvious to add a threaded cap connection to Pepicelli's container to provide for a more tightly secured cap which has to be opened by twisting rather than a mere pull in the vertical direction.

The appellant argues (brief, p. 9) that

merely because Westgate has a threaded cap would in no way serve to make Pepicelli in any way suggestive of the dissimilar container of the present invention.

We agree with the appellant that the combined teachings of Pepicelli and Westgate would not have suggested the claimed invention. In that regard, it is our opinion that one of ordinary skill in the art would not have modified Pepicelli's wall 32 and skirt 62 to have a threaded connection therebetween, as proposed by the examiner, since that would be counter to Petricelli's specific desire to permit gas flow out of the container between the skirt 62 and wall 32 so that no pressure build up is created and the container may be incubated so as to stimulate the growth of the microorganisms. Since all the limitations of claim 1, and claims 3 and 6 dependent thereon, are not suggested by the applied prior art, the examiner's rejection is reversed.

#### **New grounds of rejection**

Under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection.

1. Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention for the reasons set forth

above in the discussion of the 35 U.S.C. § 102(b) rejection of claim 1.

2. Claim 6 is rejected under 35 U.S.C. § 102(b) as being anticipated by Bourcart. Dependent claim 6 adds to parent claim 1 the limitation that the "cylinder is formed of a transparent material." Bourcart teaches (column 1, lines 54, to column 2, line 1) that the container may be made of transparent material. In view of our holding above the claim 1 is anticipated by Bourcart and that the added limitation of claim 6 is specifically taught by Bourcart, it follows that claim 6 is also anticipated by Bourcart.

3. Claims 1 and 3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Torras.

Torras discloses a container for food and beverages. As shown in Figure 1, the container 10 has a cylindrical wall 11, a bottom 12, top 13 and a crown cap 16 or screw cap (not shown). The bottom 12 and top 13 are secured to the wall 11 in the conventional manner of seam construction. The top 13 has a substantially frustro-conical wall forming shoulder S and a substantially cylindrical wall protrudes from the shoulder S to

form a neck 15. Neck 15 is provided with threads when a screw cap is utilized. Bottom 12 is provided with a cylindrical recess 17 and an upwardly extending conical portion 18, complementary with the top 13. Figure 1 of Torras shows two adjacently stacked similar containers wherein the cap 16 of the bottom container is within the cylindrical recess 17 of the top container and the upwardly extending conical portion 18 of the top container rests on the shoulder S of the bottom container.

We read claim 1 on Torras as follows: A first stackable container (Torras' upper container 10) for seasonings, such as salt, pepper and spices, comprising: a hollow cylinder (Torras' wall 11) having an integral top wall (Torras' top 13) and an integral bottom wall (Torras' bottom 12), a tubular mouth member (Torras' neck 15) formed integral with the top wall and centrally located on the top wall coaxial with the hollow cylinder, said tubular mouth member having external threads thereon (when a screw cap is employed in place of the crown cap 16 as taught by Torras) and having a reduced diameter with respect to the diameter of said top wall and extending upwardly from the plane of said top wall (see Torras' Figure 1); said bottom wall having a circular well (Torras' recess 17) centrally formed therein coaxial with said cylinder and extending upwardly into the



interior of said cylinder (see Torras' Figure 1), and said well having a selected diameter to receive the tubular mouth member of a second like container to enable the first container to be stacked on top of the second container (see Torras' Figure 1) of a second like container (Torras' bottom container 10) to enable the first container to be stacked on top of the second; a cover having an internally threaded annular skirt portion (the screw cap employed in place of the crown cap 16 as taught by Torras) removably mounted on said tubular mouth member in threaded engagement therewith and with said skirt portion extending down over said tubular mouth member (see Torras' Figure 1), and in which the outer diameter of the annular skirt portion of said cover and the inner diameter of the well are selected to enable the first container to be stacked over the second container in a close fitting sliding interlocking relationship (see Torras' Figure 1).

As to claim 3, we note that the claimed concave annular surface "reads on" Torras' conical portion 18 and that the claimed annular convex surface "reads on" Torras' conical shoulder S.

4. Claims 4 and 6 are rejected under 35 U.S.C. § 103 as being unpatentable over Torras in view of Westgate.

The teachings of Torras and Westgate have been previously set forth. Thus, after the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Torras and dependent claims 4 and 6, it is our opinion that the only differences are the limitations that a perforated cap is fitted over the tubular mouth member under the cover (claim 4) and the cylinder is formed of a transparent material (claim 6).

With regard to claim 4, it is our opinion that it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to modify Torras' food container to contain a condiment and to provide the container with a perforated cap fitted over the neck 15 (i.e., the tubular mouth member) under the screw cap (i.e., cover) as suggested by Westgate's condiment container having a fitment 15 with sifting holes 20.

With regard to claim 6, it is our opinion that it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to modify the cylindrical wall 11 of Torras' container to be transparent as suggested by Westgate's teaching to provide a glass or clear plastic jar to permit the contents of the jar to be visible.

#### CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to reject claims 1, 3 and 6 under 35 U.S.C. § 103 is reversed; and new rejections of claims 1, 3, 4 and 6 under 35 U.S.C. § 112, second paragraph, claims 1, 3 and 6 under 35 U.S.C. § 102(b) and claims 4 and 6 under 35 U.S.C. § 103 have been added pursuant to provisions of 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

Appeal No. 96-3999  
Application No. 08/395,719

Page 22

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APPENDIX

1. A first stackable container for seasonings, such as salt, pepper and spices, comprising:

a hollow cylinder having an integral top wall and an integral bottom wall, a tubular mouth member formed integral with the top wall and centrally located on the top wall coaxial with the hollow cylinder, said tubular mouth member having external threads thereon and having a reduced diameter with respect to the diameter of said top wall and extending upwardly from the plane of said top wall;

said bottom wall having a circular well centrally formed therein coaxial with said cylinder and extending upwardly into the interior of said cylinder, and said well having a selected diameter to receive the tubular mouth member of a second like container to enable the first container to be stacked on top of the second container;

a cover having an internally threaded annular skirt portion removably mounted on said tubular mouth member in threaded engagement therewith and with said skirt portion extending down over said tubular mouth member, and in which the outer diameter of the annular skirt portion of said cover and the inner diameter of the well are selected to enable the first container to be stacked over the second container in a close fitting sliding interlocking relationship.

APPEAL NO. 96-3999 - JUDGE NASE  
APPLICATION NO. 08/395,719

APJ NASE

APJ CALVERT

APJ CRAWFORD

DECISION: **AFFIRMED-IN-PART;**  
**37 CFR § 1.196(b)**

Prepared By: Delores A. Lowe

**DRAFT TYPED:** 02 Apr 98

**FINAL TYPED:**